REMARKS

Claims 1-26 are currently pending in the present application. In the instant Office Action, the Examiner has raised a single rejection:

> Claims 1-26 stand rejected under 35 U.S.C. §103(a), as allegedly unpatentable over Tao (U.S. Patent No. 6,284,007), in view of Sinwald (U.S. Patent No. 5,753,015) and T1-food.

Applicants hereby amend Claims 1, 13, 16, 18 and 19, and hereby cancel Claims 9 and 10, in order to further the prosecution of the present application and Applicants' business interests, yet without acquiescing to the Examiner's arguments. Applicants reserve the right to prosecute the original, similar, or broader Claims in one or more future application(s). These amendments do not introduce new matter and are not intended to narrow the scope of any of the claims within the meaning of *Festo*.[1]

The Claims Are Patentable Over Tao In View of Sinwald and Tl-food

The Examiner has rejected Claims 1-26 under 35 U.S.C. §103(a), as allegedly unpatentable over Tao (U.S. Patent No. 6,284,007), in view of Sinwald (U.S. Patent No. 5,753,015) and T1-food stating:

> Tao teaches a vegetable lipid-based composition and candle comprising fully hydrogenated triglycerides and free fatty acids and paraffin wax (see col., lines 50-59; col. 2, lines 49-64). The free fatty acid and triglycerides are preferably saturated (see col. 3, lines 1-2). The composition contains a free fatty acid/triglyceride mixture in a ratio from 1-99% triglycerides and from 1 to 99% fatty acid (see Example 5).
>
> Tao also teaches compositions wherein no fatty acid is present (Example 1). Tao teaches the limitations of the claims other then the differences that are discussed below.
>
> In the first aspect, Tao differs from the claims in that he does not specifically teach the claimed IV. However it would be reasonable to expect that the triglycerides of Tao would possess the claimed IV because Tao teaches that the oils are fully hydrogenated and Sinwald and Tl-food teach that fully hydrogenated vegetable oils have IV from 10 to perhaps as low as 0 (see Sinwald, col. 1-3, Tl-food, type PV and SS fully hydrogenated oils). ...
>
> In the second aspect, Tao differs from the claims in that he does not specifically teach all of the claimed proportions of triglyceride, paraffin and stearic acid. However, it is not inventive to determine these result effective variables through routine experimentation. This would especially hold true since Tao is not limited to

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[1] *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 122 S.Ct. 1831, 1838, 62 USPQ2d 1705, 1710 (2002).

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> the amount of paraffin and triglyceride/fatty acid mixture that is present in the composition. ...

Applicants respectfully disagree that Claims 1-26 are obvious over Tao in view of Sinwald and T1-food. Nonetheless, Applicants have amended Claims 1, 13, 16, 18 and 19, and have canceled Claims 9 and 10, in order to further the prosecution of the present application and Applicants' business interests, yet without acquiescing to the Examiner's arguments, and while reserving the right to prosecute the original, similar, or broader Claims in one or more future application(s). In particular, Applicants have amended Claims 1, 13, 18 and 19 to recite "greater than 60% by weight paraffin," and have amended Claim 16 to recite "greater than 70% by weight paraffin." Abundant support for these amendments can be found in the application as filed in part through original Claims 11 and 18 which recite "at least approximately 70% by weight paraffin," and "greater than 51% by weight paraffin." In addition, specific examples of candles comprising 60%, 70%, 80%, 85% and 90% paraffin are provided in Tables II and III.

All Claim Limitations are neither Taught nor Suggested

The Examiner is reminded that "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art."[2] The amended claims require greater than **60% by weight paraffin**. This clearly differs from the teaching of the primary reference (Tao), which discloses "a vegetable- lipid based composition including a vegetable lipid component and a petroleum wax wherein the composition contains *a greater concentration of the vegetable lipid component than the petroleum wax* (*See,* Tao, at column 1, lines 6-10, emphasis added). This teaching in combination with Tao's language of "up to about 49% by weight of the petroleum wax" indicates that the invention of Tao *does not read upon an excess of 50% paraffin wax*, in contrast to the Examiner's assertion (Office Action, page 2). In addition, both of the secondary references (Sinwald and T1-foods) disclose compositions (crayon and food respectively) lacking the paraffin wax component. Thus, the claimed range and that of Tao are **not** close enough to establish a prima facie case of obviousness. In fact, the claimed invention is expected to yield low-sooting or non-sooting candle compositions

[2] *See, In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

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with more favorable-economics, because these compositions comprise a greater amount of the less-expensive paraffin component, than the more-expensive fatty material component. As a *prima facie* case of obviousness has not been established, Applicants respectfully request that this rejection be withdrawn.

CONCLUSION

Applicants believe that the amendments and arguments set forth above traverse the Examiner's rejections and, therefore, request that these grounds for rejection be withdrawn. Moreover, as the amended claims contain previously presented limitations (*e.g.*, greater than 60% paraffin), which had not been properly considered by the Examiner in the Final Office Action, Applicants respectfully assert that it would be improper for the Examiner to refuse to enter the proposed amendments. Specifically, since the proposed amendments are encompassed by limitations of previously presented Claims 10, 11, and 16, it would not be appropriate for the Examiner to simply assert in an Advisory Action that the proposed amendments raise new issues that would require further consideration and/or search. However, should the Examiner believe that a telephone interview would aid in the prosecution of this application, Applicants encourage the Examiner to call the undersigned collect.

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